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10/525,381	02/23/2005	Timothy S. Stevens	36-1887	3945

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EXAMINER	
SMITH, GARRETT A	
ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/525,381	STEVENS ET AL.	
	Examiner	Art Unit	
	Garrett Smith	2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 Feburary 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 Feburary 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to the amendments filed on **23 February 2005**.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining

compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Oath/Declaration

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because of non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

5. The examiner notes that the applicant has claimed priority under 35 USC 120 to the PCT application and 35 USC 119. The instant application is the PCT application and thereby claiming priority to itself. A new oath/declaration clearly indicating which priority is claimed is required.

Specification

6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.

(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.

(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

7. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded

hyperlinks and/or other form of browser-executable code. See MPEP § 608.01. These occur on page 2, line 15 and 8 and must be removed.

8. The use of the trademarks APPLE®, QUICKTIME®, MICROSOFT®, and DIRECTSHOW® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Drawings

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "44" has been used to designate both "Template Creation Tool" and "User Profile Creation". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The reference characters "42" (page 7, line 6) and "45" (page 7, line 8) are not shown in the drawing sheets. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. See previous paragraph for reference to character "44".

11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "0.11", "0.2", "0.39", "0.40", "0.41", and "4.1". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Abstract and Title

12. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

13. The applicant is reminded that the use of references to drawings is not permitted in the abstract pursuant to 37 CFR 1.72(b). On line 5 of the abstract, the reference to 51 in the drawings has to be removed.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1 – 6 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claim 1 recites the limitation "a media article" in line 8. There is insufficient antecedent basis for this limitation in the claim. The examiner questions whether "a media article" in line 8 different from the "a media article" in line 1. For purposes of examination, the Examiner will take these terms as to refer to "a media article" in line 1.

17. Claim 13 recites the limitation "membership of a set" in line 1. "Membership" is not recited anywhere in the parent claims. The examiner questions if the term should read "membership in a set". For purposes of examination, the Examiner will take "membership of a set" as referring to the membership "in" the set of stored media data.

Claim Rejections - 35 USC § 101

18. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

19. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

20. In regard to claim 1, analyzing and arranging digital metadata means by themselves do not give a tangible result. In order for a method claim to be considered statutory, it must possess a useful, concrete, and tangible result. As such, the created organization of data does give both a useful and concrete result, however, the result never leaves the processor. Therefore the result is not a tangible result.

21. In regard to claim 2, generating data (in combination with that of claim 1) without storing the result or providing it to the user does not produce a tangible result. As the same with claim 1, the result never leaves the processor.

22. In regard to claim 3, selecting one or more sets of data (in combination with that of claim 1) without storing the result or providing it to the user does not produce a tangible result. As the same with claim 1, the result never leaves the processor.

23. In regard to claim 4, making a plurality of selections and concatenating said selections (in addition to claim 3) do not constitute a tangible result, as the result never leaves the processor.

24. In regard to claim 5, it is rejected by the same reasons as claim 1.

Claim Rejections - 35 USC § 102

25. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

26. Claims **1-6** are rejected under 35 U.S.C. 102(b), as well as understood under 35 U.S.C. 112 2nd paragraph, as being anticipated by Reber et al (US Patent 5,584,006, issued December 10, 1996).

27. **In regard to claim 1,** Reber et al teaches a method of automatically composing a media article comprising: Analyzing digital metadata associated with a first set of stored media data ([col 3, lines 52 – 54], the table of relations links the linear media data and any digitized media data), which digital metadata includes: related set identity data identifying a second set of stored media data ([col 11, lines 41 – 49] the table of relations contains the identifiers for the second set of data which is deemed equivalent); and relationship data which indicates the relationship between what is represented by the first set of stored media data and what is represented by the second set of stored

media data ([col 11, lines 41 – 49] the relationship between the two sets of media data is the equivalence of the media data including data on how the equivalent media overlap, what sequences overlap and their locations stored in the table of relationships); and arranging said first and second sets of stored media data in a media article in accordance with said analysis ([col 11, lines 39 – 41] the table of relations is analyzed by the application continuously to find equivalent media data, i.e. media data that can be part of the same time sequence from the same or different sources and arranges media data by changing sources as well as adding additional pieces of media data in accordance to the results of the analysis).

28. **In regard to claim 2**, Reber et al further teaches a method further comprising generating said identity data and said relationship data ([col 10, lines 36 - 38] relational information pertinent to the list of source identifiers is added to a list of relational information i.e. generating relationship data, [col 10, lines 46-47] any new source identifiers are added to the source list i.e. generating identity data).

29. **In regard to claim 3**, Reber et al further teaches wherein said metadata further comprises content data indicating what is represented by said sets of stored media data ([col 11, lines 5 – 7]; a time sequence that media data covers is stored in the table of relations as is shows equivalence); said method further comprising the step of selecting, from a plurality of sets of stored media data; one or more sets of stored media data in dependence upon said content data, said one or more sets including said first and second sets of stored media data ([col 11, 34-38 and col 11, lines 43 - 47]; the

application selections from set of media data the available and most complete media data based on the time sequence data).

30. **In regard to claim 4**, Reber et al further teaches making a plurality of such selections ([col 10, lines 57 – 58] covering a time sequence may take multiple sets of media data); and concatenating the results of said selections ([col 11, lines 7-8] a list is constructed of all results of the time sequence selection).

31. **In regard to claim 5**, Reber et al further teaches said arranging step arranges said sets of stored media data so as to determine whether the user sees or hears what is represented by the first set of stored media data before or after he sees or hears what is represented by the second set of stored media data ([col 11, 42 - 43] application arranges the media data in a time sequence and switches in and out media on the fly to keep what a user sees and hears in sequence).

32. **In regard to claim 6**, Reber et al further teaches said set of stored media data contains video data ([col 1, lines 17-19])

33. Claims **7-10, 14** and **15** are rejected under 35 U.S.C. 102(b) as being anticipated by Reber et al (US Patent 5,584,006, issued December 10, 1996).

34. **In regard to claim 7**, Reber et al teaches one or more memory devices storing, for each of a plurality of sets of stored media data, metadata ([col 11, lines 53-54] the table of relations is created and stored in memory) including relationship data indicating one or more relationships between the content represented in said set of stored media data and the content represented in one or more other sets of stored media data ([col

11, lines 41 – 49] the relationship between the two sets of media data is the equivalence of the media data including data on how the equivalent media overlap, what sequences overlap and their locations stored in the table of relationships); and one or more digital processors in communication with said one or more memory devices and arranged in operation to compose a media article by arranging said sets of stored media data or identifiers thereof in accordance with said relationship data ([col 11, lines 39 – 41] the table of relations is analyzed by the application continuously to find equivalent media data, i.e. media data that can be part of the same time sequence from the same or different sources, and arranges media data by changing sources as well as adding additional pieces of media data in accordance to the results of the analysis).

35. **In regard to claim 8**, Reber et al further teaches said relationship data indicates a causal relationship between what is represented by one of said sets of stored media data and what is represented by another of said sets of stored media data ([col 2, line 54], time sequences purport a causal relationship).

36. **In regard to claim 9**, Reber et al also teaches said one or more processors is further arranged in operation to provide a user with an interface enabling the user to enter said relationship data ([col 6, lines 43 – 49] Mfm_Create is an interface whereby the user can add new relationship data i.e. new time codes and sequences).

37. **In regard to claim 10**, Reber et al further teaches said metadata is stored in a database ([col 11, lines 55 – 58]), and said one or more processors are further arranged in operation to query said database to obtain identifiers of sets of stored media data whose metadata meets one or more conditions specified in said query ([col 10, lines 57-

59] a procedure of finding identifiers of media data from a query consisting of a source identifier and range identification).

38. **In regard to claim 14**, Reber et al also teaches a content store storing a plurality of sets of stored media data ([col 3, lines 39 –41]), said metadata for each set of stored media data including a pointer to the location of said set of stored media data in said content store ([col 6 line 16], media identifier is the pointer to the location of the media file).

39. **In regard to claim 15**, Reber et al further teaches said one or more memories further store one or more media element selection criteria ([col 10, lines 57-59] a procedure of finding identifiers of media data from a query consisting of a source identifier and range identification), and said one or more processors are further arranged in operation to receive a set of media element identifiers and select said input set by selecting a subset of media element identifiers in accordance with said selection criteria ([col 11, lines 39 – 41] the table of relations is analyzed by the application continuously to find equivalent media data, i.e. media data that can be part of the same time sequence from the same or different sources, and arranges media data by changing sources as well as adding additional pieces of media data in accordance to the results of the analysis).

40. Claim **7 -13**, **15**, and **16** are rejected under 35 U.S.C. 102(b), as well as understood under 35 U.S.C. 112 2nd paragraph, as being anticipated by Sweat et al (US Patent 5,619,636).

41. **In regard to claim 7**, Sweat et al teaches one or more memory devices ([col 3, line 20]) storing, for each of a plurality of sets of stored media data ([col 4, lines 12-13] functional object modules contain data that interacts and controls the interaction between object models, [col 4, lines 63-65], the "type of module" buffer contains data on the type of module each module is classified), metadata including relationship data indicating one or more relationships between the content represented in said set of stored media data and the content represented in one or more other sets of stored media data ([col 4, lines 65-66], Reference Number 48, a "connections" buffer which identifies how a module is related to another module); and one or more digital processors in communication with said one or more memory devices and arranged in operation to compose a media article by arranging said sets of stored media data or identifiers thereof in accordance with said relationship data (126, [col 8, lines 46-63], the wiring process of putting modules together based on user input).

42. **In regard to claim 8**, Sweat et al further teaches said relationship data indicates a causal relationship between what is represented by one of said sets of stored media data and what is represented by another of said sets of stored media data ([col 4, lines 65-66], 48, a "connections" buffer which identifies how a module is related to another module, [col 8, lines 50-56] at the result of "sender" module sending a output event to a "receiver" module, a triggered behavior occurs).

43. **In regard to claim 9**, Sweat et al further teaches said one or more processors is further arranged in operation to provide a user with an interface enabling the user to

enter said relationship data ([col 8, lines 56-63] the operator can link modules together through an interface).

44. **In regard to claim 10**, Sweat et al further teaches said metadata is stored in a database ([col 3, lines 54-57] database "tracks and maintains references to media"), and said one or more processors are further arranged in operation to query said database to obtain identifiers of sets of stored media data whose metadata meets one or more conditions specified in said query ([col 7, lines 12-14] operators can search for pre-created modules which can be media modules).

45. **In regard to claim 11**, Sweat et al further teaches said database comprises an object-oriented database and metadata for each set of stored media data is stored as an object in said object-oriented database ([col 3, lines 54-57]).

46. **In regard to claim 12**, Sweat et al further teaches said relationship data is stored as data, which defines the relationships between objects in the database ([col 3, lines 54-57] database "tracks and maintains references to media").

47. **In regard to claim 13**, Sweat et al further teaches membership of a set is indicated by each member of the set inheriting from a container object ([col 4, lines 32-40] a plurality of modules in a module is a container module which indicates membership of a set of related modules).

48. **In regard to claim 15**, Sweat et al further teaches said one or more memories further store one or more media element selection criteria ([col 7, lines 12-14] keyword search can be entered by the operator), and said one or more processors are further arranged in operation to receive a set of media element identifiers and select said input

set by selecting a subset of media element identifiers in accordance with said selection criteria ([col 7, lines 16-17] modules that match the query are displayed on a palette).

49. **In regard to claim 16**, Sweat et al further teaches said one or more media element selection criteria comprise a set of template data, each of said sets of template data listing a plurality of slots to be filled ([col 7, lines 12-18] palette is a template with a number of slots), and, for each slot, one or more associated requirements of media elements for filling said slot ([col 7, lines 12-18] user query sets criteria for filling the slot on the palette); and said one or more processors are further arranged in operation to provide said subset by, for each of said slots, retrieving one or more identifiers of media elements whose metadata accords with said one or more requirements for said slots ([col 7, lines 12-18] fully constructed palette can be saved and used).

Conclusion

50. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP 5027420. USP 5267351. USP 5724605. USP 5752029. USP 5754851. USP 5767846. USP 6204840. Wolz et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garrett Smith whose telephone number is (571) 270-1764. The examiner can normally be reached on Mon - Fri, 7:30 AM - 5:00 PM EST, Alt Fri Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on (571) 272-0734. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GS
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